

U.S. Patent Application Serial No. 09/888,046  
Reply to Office Action dated September 23, 2004

**Remarks:**

Applicants have read and considered the Office Action dated September 23, 2005 and the references cited therein. The disclosure has been editorially revised to correct some minor clerical errors noted by Applicants. Claims 1, 5, 16, 27, 36 and 38 have been amended to more clearly define Applicants' invention. Claim 37 has been cancelled without prejudice or disclaimer. New claims 42 to 49 have been added to define further aspects of Applicants' invention. Claims 1 to 36 and 38 to 49 are now pending in the present application and are believed to distinguish patentably over the prior art.

In the Official Action, claims 5 to 7 were rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claim 5 has been amended to provide proper antecedents for the recited terms. Accordingly, Applicants respectfully request that this objection be withdrawn.

With respect to prior art, although not specifically indicated, it appears that claims 1, 2, 5 to 13 and 16 to 39 under 35 U.S.C. §103(a) were rejected as being unpatentable over U.S. Patent No. 6,760,752 to Liu et al. ("Liu") in view of U.S. Patent No. 6,463,435 to Bergmans ("Bergmans"). The Examiner contends that Applicants' invention as defined by these claims would be obvious to one of ordinary skill in the art in view of the teachings of Liu and Bergmans.

Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Liu and Bergmans and further in view of U.S. Patent No. 6,047,259 to Campbell et al. ("Campbell"). The Examiner is alleging that Applicants' invention as defined by these claims would be obvious to one of ordinary skill in the art in view of the teachings of these references. Claims 14, 15, 40 and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Liu and Bergmans in view of the publication entitled "A digital watermark technique based on the wavelet transform and its robustness on image compression and transformation" authored by Inoue et al. ("Inoue"). The Examiner is alleging that Applicants invention as defined by these claims would be obvious

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to one of ordinary skill in the art in view of the teachings of these references. Applicants respectfully submit that the Examiner's rejections of the claims in view of the cited references are no longer appropriate for the reasons set forth below.

According to the invention as recited in independent claim 1, Applicants provide a computerized method of creating a data message for electronic transmission to a recipient. During the method, at least one image file to be included in the data message is selected. Exchange rights for the recipient are determined. The exchange rights establish at least one action available to the recipient with respect to *subsequent handling of the at least one image file by the recipient*. The at least one image file and the exchange rates are bundled to form the data message.

In contrast, Liu discloses a method and apparatus for transferring a message securely from a sender to a recipient over a network and includes at each transfer: creating a message; retrieving the public key of the recipient from an external key server just prior to sending the message; signing the message using the private key of the sender; encrypting the signed message using a public key encryption and the public key of the recipient producing an encrypted signed message; generating an email message addressed to the recipient; attaching the encrypted signed message as an attachment to the email message; and transmitting the email message to the recipient.

Bergmans discloses a digital image processing apparatus, which offers for selection by an operator at least one digital image data file for the purpose of further handling. After selection of a file by the operator, a check is made as to whether the file is provided with a security code. If a selected file is provided with a security code, the operator is asked to input an access code corresponding to the security code. If the operator inputs the correct access code, the selected file is released for further handling. The access code is maintained to allow the operator an uninterrupted series of selection actions. As a result, the operator only needs to input the access code once to be able to process all of the files.

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Applicants respectfully submit that Liu and Bergmans fail to teach or suggest the Applicants' invention as defined in the claims. Liu is directed to public key encryption and is not concerned with subsequent handling of a message once transmitted. Bergmans teaches password protection of an image file but again, similar to Liu, Bergmans is not concerned with subsequent handling of the image file once the security code is entered. As a result, during creation of data messages in the Liu and Bergmans systems, exchange rights that establish actions available to the recipient with respect to subsequent handling of the image file by the recipient are NOT included. Rather, in the Liu and Bergmans system, once a file is received by a recipient and accessed, the recipient is free to handle the file in any manner. There is nothing in the Liu and Bergmans references to suggest assigning rights to data messages to control "exchange" of data messages between recipients.

Applicants also respectfully submit that neither Campbell nor Inoue, either alone or in combination with Liu and/or Bergmans, teaches or suggests the Applicants' invention as defined by independent claim 1.

Campbell discloses an interactive method and system for managing physical exams, diagnosis and treatment protocols in health care practice. Physical exam software guides a user through a physical exam, prompting the user for input and dynamically generating context sensitive questions based on prior input. Diagnosis software generates a list of possible diagnoses based on the observations recorded from the physical exam. The user can interactively select a diagnosis by selecting a diagnosis from a rule out list and watching the display as the system dynamically updates the status of unresolved symptoms. The user can also select a treatment protocol, which is integrated with future physical exams. The treatment protocol is integrated such that future exam sessions reflect the status of the treatment protocol and remind the user which services need to be performed and when they should be performed.

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Inoue discloses a digital watermark for image signals based on wavelet transform.

Similar to Liu and Bergmans, Campbell and Inoue and any combination thereof fail to teach or suggest assigning exchange rights to a data message that establish at least one action available to the recipient with respect to *subsequent handling of the image file*.

The Examiner makes a general statement on page 9 of the Official Action that providing exchange rights in the system of Liu and Bergmans would be obvious to one of skill in the art. Applicants respectfully submit that this statement is inappropriate for the present invention, without merit and is based on hindsight analysis of the Applicants' invention as claimed. Such an analysis is clearly contrary to well established law. There is nothing in any of the references cited in the Action that teaches or suggests assigning exchange rights to a file that establishes actions available to the recipient with respect to subsequent handling of the file.

In view of the above, Applicants respectfully submit that independent claim 1 distinguishes patentably over Liu, Bergmans, Campbell and Inoue either alone or in combination and should be allowed. As claims 2 to 15, 42 and 43 are dependent either directly or indirectly on independent claim 1, which is deemed allowable, Applicants respectfully submit that these claims should also be allowed.

Independent claims 16, 27, 36 and 44 are also believed to distinguish patentably over the cited prior art for the same reasons set forth above. These claims recite rights associated with a file that determine a recipient's rights with respect to subsequent handling of a message. The prior art references cited by the Examiner are not concerned with controlling subsequent handling of delivered data messages including files. Accordingly, Applicants respectfully submit that claims 16 to 36 and 38 to 49 distinguish patentably over the cited prior art and should be allowed.


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In view of the above, Applicants respectfully submit that the present application is in order for allowance and action to that end is respectfully requested. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicants' representative at 612.336.4728.

Respectfully submitted,

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